IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Group Art Unit: 2871
Examiner: Alecia Diane Nelson

In Re PATENT APPLICATION Of:

Applicant : Liang-Chi HUANG

Serial No. : 10/032,008

Filed : December 31, 2001

For : METHOD FOR AUTOMATICALLY ADJUSTING DISPLAY QUALITY

Attorney Ref: SUND 267

RESPONSE

BOX NON-FEE AMENDMENT
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is in response to the Examiner's Action dated October 2, 2003.

The Examiner rejected claims 1-8 under 35 USC 103(a) as being unpatentable over Wu. The rejection respectfully is traversed.

The Wu patent issued after the filing of the present application, but was filed by another before the priority date of the present application. Therefore, the basis of reference as prior art is 35 USC 102(e). According to 35 USC 103(a), subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f) and (g) of section 102 does not preclude patentability under 35 USC 103 where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person. This latter provision applies the present

rejection. That is, the application and the Wu reference were, at the time that the present invention was made, owned by the same person (corporation).

During a telephone conference between the undersigned attorney and the Examiner on December 30., 2003, the Examiner indicated some concern that an affidavit may be needed to establish common ownership of the inventions. However, such an affidavit should not be required in this case. In that regard, it is noted that according to MPEP Section 706(l)(2), Part II, first paragraph:

> Applications and references (whether patents, patent applications, patent application publications, etc.) will be considered by the examiner to be owned by, or subject to an obligation of assignment to the same person, at the time the invention was made, if the applicant(s) or an attorney or agent of record makes a statement to the effect that the application and the reference were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same person
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> . . . . . The applicant(s) or the representative(s) of record have the best knowledge of the ownership of their application(s) and reference(s), and their statement of such is sufficient evidence because of their paramount obligation of candor and good faith to the USPTO.
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> The statement concerning common ownership should be clear and conspicuous (e.g., on a separate piece of paper or in a separately labeled section) in order to ensure that the examiner quickly notices the statement. Applicants may, but are not required to, submit further evidence, such as assignment records, affidavits or declarations by the common owner, or court decisions, *in addition to* the above-mentioned statement concerning common ownership.
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> For example, an attorney or agent of record receives an Office action for Application X in which all the claims are rejected under 35 U.S.C. 103(a) using Patent A in view of Patent B wherein Patent A is only available as prior art under 35 U.S.C. 102(e), (f), and/or (g). In her response to

the Office action, the attorney or agent of record for Application X states, in a clear and conspicuous manner, that:

"Application X and Patent A were, at the time the invention of Application X was made, owned by Company Z."

This statement alone is sufficient evidence to disqualify Patent A from being used in a rejection under 35 U.S.C. 103(a) against the claims of Application X. (emphasis added).

The MPEP then goes on to discuss circumstances, in which the Examiner may require further evidence. Therefore, absent such circumstances (independent evidence that raises a material doubt as to the accuracy of the applicant's representations), no further evidence should be required.

The rejection therefore is deemed to be improper and rejection accordingly should be withdrawn. The undersigned attorney wishes to thank the Examiner for her kindness and helpfulness during the telephone conference.

Based on the above, it is submitted that the application is in condition for allowance and such a Notice, with allowed claims 1-8, earnestly is solicited. Should any fee be required, please charge the same to our Deposit Account No. 18-0002 and advise us accordingly.

Respectfully submitted,

December 30, 2003
Date

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